

REMARKS

Claims 1-49 were presented for examination and were pending in this application. In an Official Action dated July 12, 2006, claims 1-49 were rejected under 35 U.S.C. § 103(a). Applicants respectfully traverse. Applicants thank Examiner for examination of the claims pending in this application and address Examiner's comments below.

The Examiner and the undersigned attorney held a telephone interview on September 6, 2006. The substance of these communications is set forth herein. The Examiner and the undersigned attorney discussed the motivation to combine the cited references, Sugiyama and Constantin. Applicants maintain that adequate motivation has not been shown to combine these references.

The Examiner and the undersigned attorney also discussed proposed amendments to clarify the claim language. Applicants have amended claims 1 and 41 and added claims 52 to 55 to incorporate these clarifications, and believe that with these amendments the claims are now in a condition for allowance. These changes are believed not to introduce new matter, and their entry is respectfully requested. In making these amendments, Applicants have not and do not narrow the scope of the protection to which Applicants consider the claimed invention to be entitled and do not concede that the subject matter of such claims was in fact disclosed or taught by the cited references. Reconsideration of the application in view of the above Amendments and the following Remarks is respectfully requested.

With respect to both claims 1 and 41, the cited art provides no suggestion or teaching to combine the references. To demonstrate motivation, the Examiner refers to paragraph 9 of Constantin, which states that "the sender need not know how the receiver classifies the document

sent or anything about how the receiver intends to route or process the document”, as providing the motivation to combine Sugiyama and Constantin. However, this statement does not articulate any motivation to combine the video printer of Sugiyama with the document processing system of Constantin.

The Examiner also states that a “further suggestion for combining would have been that the interface of Sugiyama requires a video signal input in order to have data upon which to operate...Constantin simply provides the required video signal.” However, the statement that a signal is needed in one system and available from another system does not articulate any motivation to combine the two systems.

The Federal Circuit has held that even where the combination of the references teach every element of the claimed invention, without a motivation to combine, a rejection based on a *prima facie* case of obvious is improper. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (the Examiner must show “reasons that the skilled artisan, confronted with the same problem as the inventor, and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed”). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999); MPEP 2143.01. Thus, the motivation to combine must be particularized, and the required evidence cannot be substituted with a generalized goal, as the Examiner has done in the present case.

The particularity needed to establish a motivation to combine references was further discussed in In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002). In In re Lee, the Board had determined that it was not necessary to present a source of a teaching, suggestion, or motivation to combine the references because the conclusion of obviousness may be made from common

knowledge and common sense of a person of ordinary skill in the art. However, the Federal Circuit reversed the Board of Patent Appeals and Interferences' decision and stated: "The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent ... cannot be dispensed with. The need for specificity pervades this authority." The Federal Circuit further stated that omitting the need for a specific suggestion in a particular reference to support the motivation to combine was both a legal error and arbitrary agency action. *Id.* at 1434. Thus, the generalized motivation to combine fails to rise to the level of particularity required by the Federal Circuit. In the present case, the Examiner has not met the required specificity to establish a motivation to combine the references.

Even if Sugiyama and Constantin could be combined, despite the failure of the recited art to provide a motivation or suggestions to do so, the combination of these references would not overcome the claims as amended. Claim 1 has been amended to recite the following: "a multimedia processing system coupled to the interface to receive the time-based media, the multimedia processing system automatically determining an electronic representation of the time-based media." Claim 41 has also been amended to recite the following: "automatically determining an electronic representation of the time-based media."

Neither Constantin nor Sugiyama, alone or in combination, recites these elements. Applicants further submit that the multi-functional printing system is not disclosed or rendered obvious by any of the references Wendelken, Hymel, Shieh, Chino, Stevens, Dygert, Gerber, Heilweil, Ohnishi, or Klatt, either alone or in combination with Sugiyama.

In addition, claims 2-40 and 52-53 recite additional limitations and are dependent on amended claim 1. Claims 42-49 and 54-55 recite additional limitations and are dependent on amended claim 41. Applicants respectfully submit that the pending claims are now allowable

over the cited art of record and request that the Examiner allow this case. The Examiner is invited to contact the undersigned in order to advance the prosecution of this application.

CONCLUSION

Based on the above remarks, Applicants respectfully submit that the claims presently in this case are now in condition for allowance. Reconsideration and prompt favorable action are therefore solicited.

Respectfully submitted,
PETER E. HART, ET AL.

Dated: 9/17/06

By: Brenda M. Simon
Brenda M. Simon, Reg. No.: 48,449
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel.: (650) 335-7198
Fax: (650) 938-5200